

presenting the advertising item to the user of the electronic publication after passage of a predetermined amount of time during which the electronic publication has been in use.

24. The method of Claim 7, wherein the electronic publication includes a plurality of the advertising items, and wherein said presenting step is carried out by successively presenting the advertising items to the user of the electronic publication at respective predetermined points in time which are spaced from each other by the predetermined amount of time.

8. A method for customizing advertising in an electronic publication, comprising:

creating an electronic publication which includes a plurality of content items and at least one advertising item;
permitting a user to access the electronic publication;
and

presenting the advertising item to the user of the electronic publication in response to the access of a specific content item.

26. The method of Claim 8, wherein said presenting step is carried out by presenting the advertising item to the user in response to the access by the user of a predetermined part of the specific content item.

REMARKS

Claim 25 has been amended. Claims 7-8 and 24-26 are present in the application. Reconsideration of the Application, as amended, is respectfully requested.

This will make of record a telephone conference with Examiner Jeanty on April 6, 2001. This will also make of record a subsequent telephone conference on the same day with Examiner Hafiz, who is the signatory on both the pending final rejection and the associated Advisory Action. Applicants thank both Examiners for their time and courtesy. The discussion related to Applicants' position as presented in the remarks of the Response filed on March 2, 2001. No agreement was reached. However, Examiner Hafiz did indicate that, if a further Response was submitted, it would be given careful consideration.

The foregoing amendments add to dependent Claim 25 the limitations of independent Claim 7, in order to place Claim 25 in independent form. These amendments do not make any change to the scope of Claim 25. Claim 25 stands rejected under 35 U.S.C. §102 as completely anticipated by Reilly U.S. Patent No. 5,740,549. In the paragraph which bridges pages 4-5, the pending Office Action (Paper No. 7) indicates that Claim 25 is met by the portion of Reilly which runs from line 61 in column 5 to line 10 of column 6. This ground of rejection is respectfully traversed, for the following reasons.

Claim 25 recites an electronic publication which includes an advertising item, and also recites that this particular advertising item is presented to a user after the passage of a predetermined amount of time during which the electronic publication has been in use. In addition, Claim 25 recites "maintaining information about the amount of time which the user spends reading the electronic publication during each access thereto, and setting the predetermined amount of time as a function of such information". The paragraph identified by the Examiner in Reilly is the paragraph which bridges columns 4-5. This paragraph discusses how the publisher of an

electronic publication can maintain statistical information about how many times each advertisement has been displayed, and how much time a user spends viewing each non-advertising item. However, Reilly does not teach or even remotely suggest that this statistical information could be used as a basis for adjusting any time interval, much less the specific time interval which is expressly recited in Claim 25. As noted above, the rejection of Claim 25 is for anticipation under §102. The Court of Appeals for the Federal Circuit has consistently held that:

Anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim.
Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co., 221 USPQ 481, 485 (Fed.Cir. 1984), citing *Connell v. Sears Roebuck & Co.*, 220 USPQ 193 (Fed.Cir. 1983).

Since Reilly fails to teach or even remotely suggest one of the elements of the combination recited in Claim 25, Reilly cannot possibly meet the Federal Circuit's prevailing legal standard for anticipation under §102, which requires the presence in a single reference of "each and every element" in the claimed combination. It is thus respectfully submitted that the rejection of Claim 25 under §102 is clearly improper, and must be withdrawn. Notice to that effect is respectfully requested.

Turning to independent Claim 7, this claim also recites a very specific and distinctive feature for an electronic publication containing an advertising item, where the feature involves "presenting the advertising item to the user of the electronic publication after passage of a predetermined amount of time during which the electronic publication has been in use". Claim 7 indicates precisely

when this time interval begins (when the user begins using the electronic publication), and indicates precisely when this time interval ends (the point in time when the advertising item is presented). Claim 7 stands rejected under 35 U.S.C. §102 as anticipated by Reilly. However, Reilly does not appear to teach or even suggest a time interval which has both the specific starting and the specific ending time recited in Claim 7. In particular, Reilly does not teach or suggest a time interval which begins when a user starts using an electronic publication, and which ends with presentation of an advertising item. The Advisory Action states that Reilly discloses "presenting advertisements based on calculation of time interval". This is a true statement. However, Claim 7 is not nearly this broad. Claim 7 recites a time interval having very specific starting and ending times, and the Reilly patent does not teach or suggest a time interval with these specific starting and ending times. Since the rejection is based on §102, Reilly would need to disclose exactly the same time interval that is recited in Claim 7, and Reilly fails to do so. Accordingly, it is respectfully submitted that the §102 rejection of Claim 7 is improper, and must be withdrawn. Notice to that effect is respectfully requested.

Independent Claim 8 relates to an electronic publication which includes a plurality of content items and at least one advertising item. Claim 8 recites "presenting the advertising item to the user of the electronic publication in response to the access of a specific content item". Claim 8 stands rejected under 35 U.S.C. §103 as anticipated by Reilly, but this rejection is respectfully traversed. The Examiner has not identified any disclosure by Reilly of the concept that access by a user to a particular content item is the event which triggers presentation of a specific and predetermined advertising item. Given that Reilly fails to

disclose this very specific limitation recited in Claim 8, Reilly cannot possibly anticipate Claim 8 under §102. It is therefore respectfully submitted that the §102 of Claim 8 is improper, and must be withdrawn.

Claim 26 depends from Claim 8, and recites a further refinement of the subject matter of Claim 8. In particular, Claim 26 recites "presenting the advertising item to the user in response to the access by the user of a predetermined part of the specific content item". Claim 26 stands rejected under §102 as anticipated by Reilly. The Office Action (Paper No. 7) indicates that Claim 7 is met by the paragraph at lines 38-48 in column 13 of Reilly. This rejection is respectfully traversed. The indicated paragraph in Reilly discusses how to view a content item such a news story, but never even remotely mentions any advertising item, much less how and when an advertising item might be displayed, still less the concept of presenting the advertising item in response to access by a user to a predetermined part of a specific content item. Since Reilly fails to even remotely teach or suggest a particular limitation which is expressly recited in Claim 26, Reilly cannot possibly anticipate Claim 26 under §102. It is thus respectfully submitted that the §102 rejection of Claim 26 based on Reilly is clearly improper, and must be withdrawn. Notice to that effect is respectfully requested.

Claim 24 depends from Claim 7 and is also believed to be allowable over the art of record, for example for the same reasons discussed above with respect to Claim 7.

Based on the foregoing, it respectfully submitted that all of the pending claims are fully allowable, and favorable reconsideration of this application is therefore respectfully requested. If the Examiner believes that examination of the present application may be advanced in any

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PATENT APPLICATION
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8

way by a telephone conference, the Examiner is invited to telephone the undersigned attorney at (214) 953-6684.

Although Applicants believe that no additional fees are due, the Commissioner is hereby authorized to charge any fee required by this paper, or to credit any overpayment, to Deposit Account No. 05-0765 of Electronic Data Systems Corporation.

Respectfully submitted,
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Enclosures: Marked-Up Copy of Claims showing
 Amendments (2 sheets)
 Post Card

MARKED-UP COPY OF CLAIMS SHOWING AMENDMENTS

25. (Amended) [The method of Claim 7, including the step of] A method for advertising in an electronic publication, comprising:

creating an electronic publication which includes at least one content item and at least one advertising item;

permitting a user to access the electronic publication;

presenting the advertising item to the user of the electronic publication after passage of a predetermined amount of time during which the electronic publication has been in use; and

maintaining information about the amount of time which the user spends reading the electronic publication during each access thereto, and setting the predetermined amount of time as a function of such information.

7. A method for advertising in an electronic publication, comprising:

creating an electronic publication which includes at least one content item and at least one advertising item;

permitting a user to access the electronic publication;
and

presenting the advertising item to the user of the electronic publication after passage of a predetermined amount of time during which the electronic publication has been in use.

24. The method of Claim 7, wherein the electronic publication includes a plurality of the advertising items, and wherein said presenting step is carried out by successively presenting the advertising items to the user of the electronic publication at respective predetermined points in time which

are spaced from each other by the predetermined amount of time.

8. A method for customizing advertising in an electronic publication, comprising:

creating an electronic publication which includes a plurality of content items and at least one advertising item;

permitting a user to access the electronic publication;
and

presenting the advertising item to the user of the electronic publication in response to the access of a specific content item.

26. The method of Claim 8, wherein said presenting step is carried out by presenting the advertising item to the user in response to the access by the user of a predetermined part of the specific content item.